

4-4-05

CFW 3686
/CC



ATTORNEY DOCKET NO: 70201RCE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : MARKERT
Serial No : 09/885,566
Confirm. No : 6188
Filed : June 20, 2001
For : GEAR, PARTICULARLY...
Art Unit : 3682
Examiner : Timothy P. McAnulty
Dated : April 1, 2005

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO THE DIRECTOR FOR RECONSIDERATION OF THE DECISION TO
DENY PREVIOUSLY FILED INFORMATION DISCLOSURE STATEMENT

Sir:

Applicant hereby requests that the Director review the decision to deny full consideration of the Information Disclosure Statement filed on December 2, 2004 submitted with a Petition Under 37 CFR 1.97 (1).

The Office Communication entitled Decision on Request Under 37 CFR 1.974 Consideration of Information Disclosure Statement After Allowance states that the denial to consider the IDS was for lack of certification.

After receiving the Office Communication, Applicant requested reconsideration. Attorney D.W. Kang also contacted the SPE David A. Bucci. Mr. Bucci ruled on reconsideration holding that the Petition Under 37 CFR 1.97 lacked the precise terms of

language contained in the statute. It is Applicant's position that this denial be reconsidered and the IDS as filed on December 2, 2004 be considered.

Applicant stated in the second part of the paragraph that each item of the information contained in the Information Disclosure Statement was cited in a communication from a foreign patent office in a foreign counterpart foreign application not more than three months prior to the filing of the Information Disclosure Statement. The certification had been signed.

The Examiner takes the position that the phrase is meaning the word "first". It is Applicant's contention that 37 CFR 1.97 and 37 CFR 1.98 were promulgated by the legislature to encourage submission of pertinent prior art references. Specifically, the MPEP states as follows:

"An Information Disclosure Statement filed in accordance with the provisions of 37 CFR 1.97 and 37 CFR 1.98 will be considered by the Examiner assigned to the Application. The requirements for the content of a statement have been simplified in the Rules, to encourage individuals associated in a substantive way with the filing and prosecution of a patent application to submit information to the office so that the Examiner can evaluate its relevance to the claimed invention"
MPP609.

More importantly, in the Information Disclosure Statement filed on December 2, 2004,

Applicant has filed a corresponding European Search Report along with the Information Disclosure Statement which has the dates which should have put the SPE under notice that this is for a set of references which need to be considered by the Examiner.

Specifically, the pertinent portion of the MPP609 states as follows:

"If an Information Disclosure Statement includes a copy of a dated communication from a foreign patent office which clearly shows that the statement is being submitted within three months of the date of the communication, the copy will be accepted as the required "statement under 37 CFR 1.97 (e) (1)". It will be assumed, in the absence of evidence to the contrary that the communication was for a counterpart foreign application".

Therefore, without any statements to the contrary, the Information Disclosure Statement as filed on December 2, 2004 should have been transferred to the proper authority for substantive review and be made part of the record. Applicant hereby requests that the decision be rescinded and the IDS as filed on December 2, 2004, be substantively reviewed.

Favorable consideration is requested. Early consideration of the Information Disclosure Statement filed December 2, 2004 is requested.

Respectfully submitted
for Applicant,

By: _____



John James McGlew
Registration No. 31,903
McGLEW AND TUTTLE, P.C.

JJM/DWK:jms
70201RCE.15

DATED: April 1, 2005
SCARBOROUGH STATION
SCARBOROUGH, NEW YORK 10510-0827
(914) 941-5600

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE
IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 13-
0410.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH
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McGLEW AND TUTTLE, P.C.

BY: Maria Hannell DATE: April 1, 2005



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P.O. Box 1450
Alexandria, VA 22313-1450
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PETITION TO ACCEPT INFORMATION DISCLOSURE
STATEMENT AFTER NOTICE OF ALLOWANCE

Sir:

Applicant has received a European Search Report dated September 15, 2004 from a corresponding European application. This Search Report cites 2 references as Category X as well as other references cited as Category E and A. At least some of these references have not yet been considered by the U.S. Examiner. A copy of each of the references is attached. Applicant's representative certifies that the European Search Report was issued less than three months ago and indeed this European Search Report was received after the issuance of the Notice of Allowance in this case.

Patent Abstracts of Japan Bd. 016 Nr. 187 corresponding to JP 04025393 A has been cited in the corresponding European Search Report under Category X with regard to the

European claims 1-10, 13-16, 18, 20, 23 and 24. This reference discloses an industrial robot with input shaft of a speed reducer formed hollow coaxially with the output shaft of the speed reducer, fixing the detection shaft wherein one side is led to the output shaft until the input side with its penetrating through the hollow part of the input shaft and providing a detection piece at the other end of this detection shaft is provided. No copy of the corresponding JP04025939 reference is available to Applicant at this time.

U.S. Patent No. 4,592,697 A has been cited in the corresponding European Search Report under Category X with regard to the corresponding European claims 1-10, 13-17, 20, 23, and 24. This reference discloses a gravity off-setting device for mounted between a fixed point located above a pivotable point of the rocking arm at a predetermined distance and substantially in vertical alignment therewith, and an arbitrary point on the rocking arm, the gravity balancing device including a compression spring having a spring constant K of a value corresponding to the load W at the arbitrary point as divided by the distance A , and a free length corresponding to the sum of the length l between the fixed and the arbitrary points and the initial set length l' of the compression spring, and adapted to apply a counter-balancing tensile force varying in proportion to the distance between the fixed and arbitrary points. A copy of this reference is enclosed and is in English.

EP 1 172 182 A has been cited in the corresponding European Search Report under Category E with respect to claims 1-10, 13-15, 20, 23, and 24. This reference discloses a traction drive speed reducer which comprises circumscribed axes, a plurality of intermediate axes arranged contracting around outer peripheral of the circumscribed axes, and inscribed

cylinders inscribing the outer peripheral of the intermediate axes, in which a supporting member to rotatably support the intermediate axes is fixed, a drive motor is connected to at least one of the plurality of intermediate axes, and an output is taken from the circumscribed axes having the larger diameter than the outer diameter of the intermediate axes. This reference is in English and a copy is enclosed.

U.S. 5,203,748 A has been cited in the corresponding European Search Report under Category A with regard to claim 1. This reference discloses a planetary roller speed reducer including a sun roller mounted rotatably on a pedestal and a plurality of planetary rollers having a central portion with a narrowed diameter and mounted rotatably on the pedestal. This reference is in English and a copy is enclosed.

As the references are material, it is requested that the references be considered. However, as the references only add art already considered by the Examiner material which does not teach or suggest the invention as now claimed or technological background prior art, it is asserted that the claims as allowed patentably define over the prior art cited in the Office Action dated January 21, 2004.

Respectfully submitted
for Applicant,

By: 

John James McGlew
Registration No. 31,903
McGLEW AND TUTTLE, P.C.

JJM/DWK:jms

Enclosed: Credit Card Payment Form
70201RCE.11



DATED: December 2, 2004
SCARBOROUGH STATION
SCARBOROUGH, NEW YORK 10510-0827
(914) 941-5600

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE
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McGLEW AND TUTTLE, P.C.
SCARBOROUGH STATION, SCARBOROUGH, NY 10510-0827

BY: *Jonathan Foyte* DATE: December 2, 2004